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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|---------------------|------------------|
| 10/788,966 | 02/25/2004 | Leonard Pinchuk | BSI-430US10 | 8808 |
| 23122 | 7590 | 10/23/2007 | EXAMINER | |
| RATNERPRESTIA | | | PELEGRINO, BRIAN E | |
| P O BOX 980 | | | ART UNIT | PAPER NUMBER |
| VALLEY FORGE, PA 19482-0980 | | | 3738 | |
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| | | | 10/23/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

| | |
|---------------------|----------------|
| Application No. | PINCHUK ET AL. |
| 10/788,966 | |
| Examiner | Art Unit |
| Brian E. Pellegrino | 3738 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 36-39 is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____.
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ 5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment of 7/26/07 has been entered with the finality of that action withdrawn and a new action on the merits follows.

Assignee Consent

1) Applicant must provide the assignee's written consent to the reissue in accordance with 37 CFR 1.172(a). Where no assignee exists, applicant should affirmatively state that fact. This can be done by simply checking the "NO" box of item 7 of Form PTO/SB/50 (which form may be signed by the inventors, or by a registered practitioner). If the file record is silent as to the existence of an assignee, it will be presumed that an assignee does exist. See MPEP 1410.01(l). To cure this defect, applicant may use Form PTO/SB/53 attached to this letter. In the current application, there is no assignment recorded. It is not clear the assignee in the parent case STILL intended to consent the filing of the current divisional reissue case. Boston Scientific Corp. (see terminal disclaimer 9/21/06) was listed as assignee. Corvita Corporation was listed as assignee in the assignment field in the parent case (see 2/25/04 reissue oath/declaration). Exactly, who is the correct assignee?

Oath/Declaration

2) The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

A) There is a missing inventor, applicant, Rysler Alcine, in the reissue oath/declaration of 2/25/04. A new petition under 37 CFR 1.47 to accept missing signature is required in this divisional reissue application.

B) Additionally, the Reissue Declaration filed 2/25/04 failed to properly identify at least one 35 U.S.C.251 error. It is not sufficient for an oath /declaration to merely state "1. Originally the claims required that the liner of the trunk component have both a generally cylindrical upper body portion and a generally cylindrical lower body portion. The error is that this is unduly narrow in that the liner need only have a generally cylindrical body portion and two leg portions. 2. Originally the claims required several steps to make a supportive graft, including inserting and inflating a liner". The error here is that the original claims were too narrow. Patentees seek to obtain claims having a scope broader than the scope of the claims in the issued patent ". Rather, the oath /declaration must specifically identify an error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. (MPEP 1414 II. (C)).

C) An amendment was filed 7/26/07 in which claims were deleted after the filing of the Declaration of 2/25/04. A supplemental oath or declaration is

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required under 37 CFR 1.175 (b) to cover errors made by the amendment. To cure this defect, applicant should use Form PTO/SB/51S attached to this letter.

The reissue claims broaden the scope of the patented claims in at least one respect even though they are narrower in other respects. MPEP 1412.03(I).

Therefore, the Supplemental Declaration must be signed by all inventors (not the assignee). MPEP 1414.01 (III). See also *In re Hayes*, 53 USPQ 2d 1222.

Claim Objections

3) A) Amendment filed 7/26/07 failed to comply with 37 CFR 1.173(c).

Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all *patent* claims and all added claims as of the date of the submission. (MPEP 1453 (II)). Amendment submitted 7/26/07 failed to include a complete listing of all of the claims with status identifiers..

B) Amendment filed 7/26/07 failed to comply with 37 CFR 1.173((b)(2)).

All amendments in the reissue application must be made relative to (i.e., vis- à-vis) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment (37 CFR 1.173(g)).

Therefore, new claims 36-39 of amendment filed 7/26/2007 need to be underlined.

C) Note that numbering of claims will follow that of the patented claims according to 37 CFR 1.173 (e), new claims 36-39 will be renumbered as 31-34.

Certificate of Correction

4) The changes made in the Certificate of Correction must be made in the current divisional reissue application. Without bracketing or underlining. This should be incorporated as part of the original patent and not as changes in the reissue. A clean copy of the specification with the Certificate of Correction changes incorporated is required.

Terminal Disclaimer

5) A new reissue oath/declaration for current reissue application is required to cover the terminal disclaimer filed in the parent patent, SN 08/863,964, now US Pat. 5,855,598, to be shortened by the expiration date of US Pat. 5,639,278 (copy filed on 2/25/04).

Allowable Subject Matter

Claims presented as 36-39 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the Special Program Examiner, Henry Yuen, can be reached on 571-272-4856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

